

Remarks

Claims 1-18 are pending in the application, and each was rejected. By this paper, claims 1, 2, 5, 10 and 11 are amended, and claims 19 and 20 are added. Based on the following, consideration of the new and amended claims and reconsideration of the remaining claims are requested.

Specification

The Examiner objected to the Abstract based on a number of formalities. By this paper, the Abstract is amended to conform to the Examiner's requests.

Double Patenting

The Examiner rejected claims 1-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,425,365 (Peters et al.) and claims 1-27 of U.S. Patent No. 6,604,502 (Bisaro et al.). The MPEP states that in order to establish *prima facie* obviousness, all of the claim limitations of an invention must be taught or suggested by the prior art. MPEP § 2143.03, 8th ed., Rev. 1. Further, because Peters et al. and Bisaro et al. are cited in an obviousness-type double patenting rejection, it is appropriate to primarily look to the claims of these references, and to only rely on the specification for clarification. MPEP § 804 (II)(B)(1), 8th ed., Rev. 1. In fact, the MPEP states that "the disclosure of the patent may not be used as prior art." *Id.*

An examination of the claims of the present application shows that each of the claims has limitations which are neither taught nor suggested by the claims of Peters et al. or Bisaro et al. For example, amended claim 1 of the present application recites a system to control an engine shutdown comprising "at least one controller configured to control an engine shutdown routine, including controlling engine torque and controlling engine speed." None of the claims in Peters et al. or Bisaro et al. teach or suggest such limitations. For example, none of the claims in Peters et al. or Bisaro et al. even mentions engine torque; therefore, there is no suggestion for a system that includes a controller which operates to control the engine torque. Thus, amended claim 1 of the present application includes limitations which are

neither taught nor suggested by the claims in Peters et al. or the claims in Bisaro et al. Therefore, with regard to amended claim 1, the MPEP requirements for *prima facie* obviousness are not met.

Similarly, amended claim 10 of the present application recites a method to control an engine shutdown for a hybrid electric vehicle which includes the steps of "controlling engine torque; and controlling engine speed." The analysis used above with regard to amended claim 1 is also applicable to amended claim 10. None of the claims in Peters et al. or Bisaro et al. teach or suggest a method to control engine shutdown for a hybrid electric vehicle that includes controlling engine torque and controlling engine speed. Thus, amended claim 10 also includes limitations which are neither taught nor suggested by the claims of Peters et al. or the claims of Bisaro et al. Therefore, with regard to amended claim 10, the MPEP requirements for *prima facie* obviousness are not met.

Amended claim 1 is the base claim for claims 2-9. Similarly, amended claim 10 is the base claim for claims 11-18. Each of these dependent claims contains all of the limitations of its respective base claim, as well as additional limitations which further distinguish it from the cited references. Therefore, each of the dependent claims contains limitations which are neither taught nor suggested by the claims of Peters et al. or the claims of Bisaro et al., and the MPEP requirements for *prima facie* obviousness are not met.

Claim Rejections—35 U.S.C. § 102

The Examiner rejected claims 1 and 10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,318,334 (Reale et al.). The Examiner states that "[c]laims 1 and 10 are deemed broad enough as described to the method for reducing hydrocarbon emissions in an engine of Reale et al." The MPEP states that "'a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.'" MPEP § 2131, 8th ed., Rev. 1 (citation omitted). The MPEP further states that "'the identical invention must be shown in as complete detail as is contained in the claim.'" *Id.* (citation omitted).

By this paper, claims 1 and 10 are amended to more particularly point out and distinctly claim the subject matter of the invention. Applicants submit that amended claims 1 and 10 each contain elements that are not expressly or inherently found in Reale et al. For example, amended claim 1 recites "at least one controller configured to control a two-stage engine shutdown routine, including controlling engine torque and controlling engine speed." No such elements are expressly or inherently described in Reale et al. Similarly, amended claim 10 recites a method to control an engine shutdown for a hybrid electric vehicle that includes "controlling engine torque; and controlling engine speed." These elements are also not expressly or inherently described in Reale et al. It is therefore submitted, that in regard to amended claims 1 and 10 of the present application, the MPEP definition of anticipation is not met.

Finally, new claims 19 and 20 respectively depend from amended claims 10 and 1, and thus contain all of the limitations of those independent claims, as well as additional limitations which further distinguish them from the cited references. Accordingly, allowance of each of the pending claims is requested.

Respectfully submitted,

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